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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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08/162,984 12/08/93 BOUCHARD

H 12907281

PEABODY EXAMINER

12M2/0525

THOMAS L. IRVING
FINNEMAN, HENDERSON, FARABOW,
GARRETT & DUNNER
1300 I STREET, N.W.

This is a communication from the examiner in charge of your application.
U.S. PATENT AND TRADEMARK OFFICE
COMMISSIONER OF PATENTS AND TRADEMARKS

ART UNIT PAPER NUMBER

1201 26

DATE MAILED: 05/25/95

This application has been examined Responsive to communication filed on 4/27/95 This action is made final.

A shortened statutory period for response to this action is set to expire 3 MONTHS from the date of this letter.
Failure to respond within the time period will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENTS ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice re Patent Drawing, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449
4. Notice of Informal Patent Application, Form PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474.
6.

Part II SUMMARY OF ACTION

1. Claims 5, 13, 24, 54, 62, 73, 103-139, 140-142 are pending in the application.
Of the above claims, 5, 13, 24, 54, 62, 73, 103-139 are withdrawn from consideration.
2. Claims _____ have been cancelled.
3. Claims 140-142 are allowed.
4. Claims _____ are rejected.
5. Claims _____ are objected to.
6. Claims _____ are subject to restriction or election requirement.
7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. Formal drawings are required in response to this Office action.
9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable. not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. The proposed additional or substitute sheet(s) of drawings, filed on ____ has (have) been approved by the examiner. disapproved by the examiner (see explanation).
11. The proposed drawing correction, filed on ____ has been approved. disapproved (see explanation).
12. Acknowledgment is made of the claim for priority under 35 USC 119. The certified copy has been received not been received been filed in parent application, serial no. ____; filed on ____.
13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. Other

EXAMINER'S ACTION

08/162,984

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Art Unit: 1201

The instant communication is responsive to applicants' papers filed 4-20-95 (paper #s 23-24) and 4-27-95 (paper #25).

Applicant's election with traverse of 4-20-95 in Paper No. 24 is acknowledged.

1. Request for reconsideration of the election of species requirement:

The species election requirement is hereby withdrawn by the examiner for Group I invention which now contains claims 140-142. Although the claims are drawn to more than one patentably distinct species, it would not pose an undue burden to the PTO to examine all the subject matter of claims 140-142 together in the instant case.

2. Request for rejoinder of invention for Groups II-IV:

The traversal of the restriction requirement is on the ground(s) that although the inventions of Groups II-IV are separably patentable, the literature search would be the same, and no serious burden should result from examining these inventions together. This is not found persuasive because the invention are drawn to different chemical processes of making which require materially different process steps which would require different searches in the journal, technical and industrial literature and therefore would pose an undue burden on

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the PTO to examine more than one of these inventions in the instant case.

The requirement is still deemed proper and is therefore made FINAL.

3. Grouping of amended claims for restriction requirement made final:

- I. Claims 140-142, drawn to compounds;
- II. Claims 5, 54 and 115-139 drawn to methods of making;
- III. Claim 13 and 62 drawn to methods of making;
- IV. Claim 24 and 73 drawn to methods of making;
- V. Claim 103, drawn to compounds;
- VI. Claims 104-106, drawn to methods of making;
- VII. Claims 107-111, drawn to compounds;
- VIII. Claims 112-114, drawn to methods of making.

4. Claims withdrawn by the examiner:

Claims 5, 13, 24, 54, 62, 73 and 103-139 are withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention, the requirement having been traversed in Paper No. 24.

5. Allowable subject matter:

Applicants claims 140-142 are drawn to allowable subject matter.

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6. Proposal of interference with U.S. Patent 5,254,580:

a) The examiner subsequent to this office action will prepare and transmitted Form PTO-850 recommending to the Administrative Patent Judge the institution of an interference between applicants elected invention (claims 140-142) and U.S. Patent 5,254,580 granted to Chen et al. based on the application S.N. 08/029819, filed Oct. 19, 1993.

b) Three counts will be proposed and correspond to the proposed counts submitted by applicants in Paper #24.

c) Applicants will be designated as the senior party to the interference based on foreign priority to French application S.N. 92 14813, filed Dec. 9, 1992.

7. Suspension of prosecution:

All claims are allowable. However, due to a potential interference, ex parte prosecution is SUSPENDED FOR A PERIOD OF THREE MONTHS FROM THE DATE OF THIS LETTER.

Upon expiration of the period of suspension, applicant should make an inquiry as to the status of the application.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John D. Peabody III, Ph.D. whose telephone number is (703) 308-4690.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

J.D.P. III

J.D.P. III

May 23, 1995

JOHANN RICHTER
JOHANN RICHTER
SUPERVISORY PATENT EXAMINER
GROUP 1200

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